

REMARKS

Reconsideration of this application is respectfully requested. Applicants believe that consideration of this amendment is proper because they have attempted to comply with every requirement expressly set forth in the previous Office Action dated August 19, 2008 (Paper No. 20080817) and believe the application is now in condition for allowance.

Please cancel claims 10-14 without prejudice as being drawn to a non-elected invention.

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,268,042 ("Baig I") in view of U.S. Patent Publication No. 2002/0139611 ("Baig II"). The Examiner contends that Baig I teaches all elements of Applicants' claimed invention except the presence of aggregate particles on the front surface of the tile, which is taught in Baig II. Applicants respectfully traverse this rejection.

Baig I recites a panel having approximately 0 to 33% mineral wool. This appears to overlap Applicants' claimed range of 17 to 25% by weight. However, the Examiner has failed to note that the composition of Baig I is calculated on a different basis than that of Applicants' claims. It is clearly stated in Baig I that the compositions are on a dry basis, thus no water is present. (Abstract and Col. 4, lines 37-38) In contrast, one element of Applicants' claims

is a starch gel that includes at least 82.7% water (Page 4, line 16). For example, when calculated on a dry solids basis, the composition of Applicants' Example 1 includes about 71% mineral wool. This composition is more than twice the maximum 33% mineral wool taught by Baig I.

Further, it is impossible to determine the amount of starch gel in the product of Baig I. Although Baig I states a dispersion is formed (Col. 4, line 11), it fails to specifically recite any amount of water added to the components. The dispersion is then dewatered by several methods (Col. 4, line 16), changing whatever amount of water that was initially added. The amount of water removed by dewatering is not measured or controlled. Further, not all of the water is removed, some is chemically combined with the starch to form the gel (Col. 3, lines 20-21) or with calcium sulfate hemihydrate or anhydrite to form gypsum (Col 3, lines 58-60). Therefore, it is not possible to determine the amount of starch gel that may be present from the information presented in Baig I.

The Examiner contends that the rest of the materials that form the 75 to 83 weight percent of the core of Baig I are similar to the starch gels of Applicants' claimed composition. Again, the Examiner has failed to note the absence of water in the disclosed compositions of Baig I. The compositions in Baig I are all stated on a dry basis and, as such, would form no gel. Obviously some amount of water is added to make a dispersion that is capable of being

dewatered. However, with no amounts of water specified in this reference, the Examiner cannot show a teaching that the claimed amounts of starch gel are revealed by this reference.

Further, the Exemplar argues that the general conditions of the claim are disclosed in the prior art. Applicants contend that this is incorrect. When considered on a consistent basis, the references teach less than half the amount of mineral wool as Applicants' claimed composition. The amount of starch gel in Baig cannot be determined. There is no teaching or suggestion of the amount of water used in the Baig compositions. Applicants contend that the general conditions of the claim cannot be met where none of the references teach the range of any of the claimed components.

Baig II is relied upon to teach that the front surface of the tile is coated with coarse particles. Applicants' amended claims now recite that the particles are pressed into the surface of the tile as described on page 3, lines 18-22. This ensures good bonding between the particles and the substrate surface. This feature is not taught or suggested by either of the Baig references.

Since several features of Applicants' claims are absent, no *prima facie* case of obviousness has been established. Further, it would not be obvious to an ordinary artisan that a quality tile could be produced from the claimed composition with the Baig references before her. Applicants therefore respectfully

Appl. No. 10/789,000
Amdt. dated November 13, 2008
Reply to Office Action of August 19, 2008

request that the outstanding rejection be withdrawn and the subject claims be allowed to issue.

By the above arguments and amendments, Applicants believe that they have complied with all requirements expressly set forth in the pending Office Action. Issuance of a Notice of Allowance on the remaining allowed claims is respectfully requested. Should the Examiner discover there are remaining issues which may be resolved by a telephone interview, she is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,
GREER, BURNS & CRAIN, LTD.

/carole a. mickelson/
By:
Carole A. Mickelson
Registration No. 30,778

November 13, 2008
300 South Wacker Drive, Suite 2500
Chicago, Illinois 60606
(312) 360-0080
Customer No. 45455
P:\DOCS\2033\80621\DL5889.DOC